[10191/4189]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s)	:	Wilhelm FAHRBACH et al.
Serial No.	:	10/538,526
Filed	:	December 12, 2005
For	:	DEVICE FOR A LINE TERMINATION OF TWO-WIRE LINES
Art Unit	:	2819
Examiner	:	Dylan WHITE
Confirmation No.	:	3666

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Date: November 24, 2008 Reg. No. 36,197

Signature: _____
Jong H. Lee

APPELLANTS' APPEAL BRIEF
UNDER 37 C.F.R. § 41.37

S I R :

Applicants filed a Notice of Appeal dated June 18, 2008 (received at the PTO on June 23, 2008), appealing from the Final Office Action dated December 20, 2007, in which claims 7, 8 and 11-13 of the above-identified application were finally rejected. This Brief is submitted by Applicants in support of their appeal.

I. REAL PARTY IN INTEREST

The real party in interest in the present appeal is Robert Bosch GmbH of Stuttgart, Germany. Robert Bosch GmbH is the assignee of the entire right, title, and interest in the present application.

II. RELATED APPEALS AND INTERFERENCES

No appeal or interference which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal is known to exist to the undersigned attorney or is believed by the undersigned attorney to be known to exist to Applicants.

III. STATUS OF CLAIMS

Claims 7, 8 and 11-13 are currently pending in the present application and are being appealed. Claims 1-6, 9 and 10 have been canceled. Among the appealed claims, claim 7 is independent; and claims 8 and 11-13 ultimately depend on claim 7.

IV. STATUS OF AMENDMENTS

No amendment has been filed subsequent to the Final Rejection mailed on December 20, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

With respect to independent claim 7, the present invention provides a device for providing a line termination of a two-wire line (Fig. 1, CAN-H and CAN-L), comprising:

a first terminating resistor (107) and a second terminating resistor (108) provided between the two wires of the two-wire line, wherein the first and the second terminating resistors are connected in series; (Substitute Specification, p. 3, l. 12-21); and

at least one switching arrangement (105 or 106) provided between the first and second terminating resistors, wherein the at least one switching arrangement is configured to selectively individually separate each of the first and second terminating resistors from the two-wire line (p. 1, l. 28-33; p. 3, l. 24 – p. 4, l. 9).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejections are presented for review on appeal in this case:

(A) Whether pending claims 7, 8 and 13 are anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,700,823 (the "Rahman" reference).

(B) Whether pending claim 11 is unpatentable under 35 U.S.C. § 103(a) in view of the "Rahman" reference and U.S. Patent No. 6,853,213 (the "Funaba" reference).

(C) Whether pending claim 12 is unpatentable under 35 U.S.C. § 103(a) in view of the "Rahman" reference and U.S. Patent No. 6,324,044 (the "Teggatz" reference).

VII. ARGUMENTS

A. Rejection of Claims 7, 8 and 13 under 35 U.S.C. § 102(e)

Claims 7, 8, and 13 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,700,823 (the "Rahman" reference). Applicants respectfully submit that claims 7 and 8 are allowable over the "Rahman" reference for the following reasons.

To anticipate a claim under § 102(e), a single prior art reference must identically disclose each and every claim element. See Lindeman Machinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 703 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy , 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

The "Rahman" reference does not identically disclose, or even suggest, the feature that "at least one switching arrangement is configured to selectively individually separate each of the first and second terminating resistors from the two-wire line," as recited in claim 7; instead, the "Rahman" reference shows a switching arrangement that simultaneously and non-individually activates the resistors: "Switches 112 are used to connect or disconnect resistors 108 and 110 across lines 106." (Rahman reference, column 3, lines 5 to 6). In fact, both switches have been given the same number in each embodiment of the "Rahman" reference, indicating identical and not individual functionality. (See, e.g., Figures 1 to 3). Nowhere in the reference is it disclosed, or even suggested, to selectively individually separate each of the first and second terminating resistors, as recited in claim 7.

In the Advisory Action mailed on June 13, 2008, the Examiner contends that (a) Rahman "does not state that the switches (more than one transistor) are controlled by a single control signal," and (b) Rahman "states that a transistor (there are two switches in Fig. 2 of Rahman) are controlled by some control signal, therefore each transistor (two in the instant case) can have a different control signal." However, the Examiner's contention both mischaracterizes the Applicants' argument and the actual disclosure of Rahman.

First, Applicants argument is that the Rahman does not provide any disclosure to "selectively individually separate each of the first and second terminating resistors from the two-wire line" as recited in claim 7, and the Examiner's contentions (i.e., that Rahman "does not state that the switches (**more than one transistor**) **are** controlled by a single control signal," and that each transistor **can** have a different control signal) simply do not negate the Applicants' argument.

Second, to the extent the Examiner's contention that Rahman "does not state that the switches (more than one transistor) are controlled by a single control signal" is relevant to somehow negate the Applicants' argument, the Examiner is clearly ignoring the actual words of Rahman: Rahman unequivocally states that "**switches** 112 may be programmable switches by using **a transistor**," the plain meaning of which statement is that **both switches 112** are controlled by **a single transistor**. In addition, Rahman unequivocally states that "[s]witches 112 **are** used to connect or disconnect **resistors 108 and 110** across lines 106," which statement clearly does not teach the feature "selectively individually separate each of the first and second terminating resistors from the two-wire line."

Third, to the extent the Examiner implicitly contends that **two transistors** are disclosed in Rahman, there is no disclosure in Rahman to support this contention. In any case, even if one assumed for the sake of argument that Rahman somehow did disclose two transistors, the mere theoretical possibility that each transistor **can** have a different control signal simply does not support the conclusion that Rahman **actually teaches** using different control signals.

Therefore, for at least the foregoing reasons, claim 7 and its dependent claims 8 and 13 are not anticipated by the "Rahman" reference, and it is respectfully requested that this anticipation rejection be withdrawn.

B. Rejection of Claim 11 under 35 U.S.C. §103(a)

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over the "Rahman" reference in view of U.S. Patent 6,853,213 (the "Funaba" reference). Applicants respectfully submit that the combination of the "Rahman" and "Funaba" references does not render obvious claim 11 for the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent that the Examiner may be relying on the doctrine of inherent disclosure to support the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 11 ultimately depends on claim 7. As noted above, the "Rahman" reference fails to anticipate claim 7. Furthermore, the "Funaba" reference fails to remedy the deficiencies of the "Rahman" reference in regards to the rejection of claim 7. Therefore, dependent claim 11 is allowable over the combination of the "Rahman" and "Funaba" references. For at least these reasons, the rejection of claim 11 should be reversed.

C. Rejection of Claim 12 under 35 U.S.C. § 103(a)

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the "Rahman" reference in view of U.S. Patent 6,324,044 (the "Teggatz" reference). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons. Claim 12 ultimately depends on claim 7. As noted above, the "Rahman" reference clearly fails to anticipate claim 7, as presented. Furthermore, the "Teggatz" reference fails to remedy the deficiencies of the "Rahman" reference in regards to the rejection of claim 7. Therefore, dependent claim 12 is allowable over the combination of the "Rahman" and "Teggatz" references, and the rejection should be reversed.

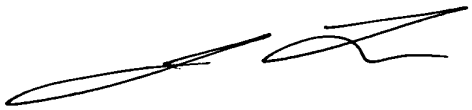
VIII. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the final rejections of claims 7, 8 and 11-13 should be reversed.

Claims Appendix, Evidence Appendix and Related Proceedings Appendix sections are found in the attached pages.

Respectfully submitted,

KENYON & KENYON LLP



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APPENDIX TO APPELLANTS' APPEAL BRIEF UNDER 37 C.F.R. § 41.37

CLAIMS APPENDIX

The claims involved in this appeal, claims 7, 8 and 11-13, in their current form after entry of all amendments presented during the course of prosecution, are set forth below:

7. A device for providing a line termination of a two-wire line, comprising:

a first terminating resistor and a second terminating resistor provided between the two wires of the two-wire line, wherein the first and the second terminating resistors are connected in series; and

at least one switching arrangement provided between the first and second terminating resistors, wherein the at least one switching arrangement is configured to selectively individually separate each of the first and second terminating resistors from the two-wire line.

8. The device as recited in Claim 7, further comprising:

a switching logic for triggering the at least one switching arrangement as a function of an input signal.

11. The device as recited in Claim 8, wherein the input signal is generated by an arithmetic function block.

12. The device as recited in Claim 7, wherein the two-wire line is a part of a CAN bus system, and wherein the device assumes at least one of a receive function and a transmit function in the CAN bus system.

13. The device of claim 7, wherein the at least one switching arrangement comprises a first switching arrangement to selectively separate the first terminating resistor from the two-wire line and a second switching arrangement to selectively separate the second terminating resistor from the two-wire line.

EVIDENCE APPENDIX

In the present application, there has been no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132, or other evidence entered by the Examiner and relied upon by Appellants in the present appeal.

RELATED PROCEEDINGS APPENDIX

No appeal or interference which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal is known to exist.